

## REMARKS

This Response is submitted in reply to the Final Office Action dated April 21, 2005. Claims 1 to 10, 18 and 20 have been amended. Claim 19 stands previously cancelled.

A Request for Continued Examination and a Petition for a Three Month Extension of Time to file this Response are submitted herewith. A check in the amount of \$1810.00 is submitted herewith to cover the cost of the RCE and the three-month extension. Please charge deposit account number 02-1818 for any insufficiency of payment or credit any overpayment.

The Office Action rejected Claims 1, 11, 18 and 21 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 18 of U.S. Patent No. 6,648,754. The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated reshuffling or re-introduction of player rejected offers into the game of Baerlocher in order to ensure that in a fixed set of selection options the odds of choosing a particular option remain consistent through multiple player selections. Applicants respectfully disagree with this rejection and submit that the Office Action improperly relies on hindsight reasoning as a justification for this rejection. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. MPEP §2145; *ATD Corp. v. Lydall*, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998). When the Examiner fails to explain how the skilled artisan would have been motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been made in hindsight, which is improper. *In re Gorman*, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). In this case, it is respectfully submitted that the Office Action improperly used hindsight reasoning to conclude that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate reshuffling or re-introduction of player rejected offers into the game of Baerlocher. Nonetheless, to expedite prosecution of such claims, Applicants are hereby submitting a Terminal Disclaimer, as indicated in the Office Action, to overcome these

rejections over U.S. Patent No. 6,648,754. Accordingly, Applicants respectfully request that Claims 1, 11, 18 and 21 are now in condition for allowance.

The Office Action rejected Claims 1 to 10, 11 to 18, 20 and 21 under 35 U.S.C. §102(e) as being anticipated by Baerlocher et al. (U.S. Patent No. 6,648,754).

Baerlocher relates to a gaming device having a game with a plurality of player selectable selections. A plurality of the selections are each associated with a numbers of steps. Different numbers of steps are associated different offers. The gaming device enables a player to pick selections to accumulate steps. The gaming device enables the player to accept or reject the offer associated with the accumulated number of steps. The game ends when the maximum number of offers have been awarded, the player accepts an offer, or the player's accumulated steps meet or exceed a termination limit equal to a number of steps.

Amended independent Claim 1 is directed to a gaming device having a game including a plurality of offers, a plurality of player selectable masked selections, and a display device. The gaming device includes a processor adapted to communicate with the display device. The processor is adapted to: (a) directly associate the offers with the selections, (b) enable a player to select one of the selections, (c) reveal the offer associated with the selected selection to the player, (d) enable the player to accept or reject the revealed offer, and (e) repeat steps (a) to (d) at least once if the player rejects the revealed offer, wherein if the player rejects the revealed offer, the revealed offer is reassociated with one of the masked selections for at least one subsequent selection.

The Office Action states that Baerlocher includes a processor adapted to reveal the value associated with the selected selection to the player. Applicants respectfully disagree and submit that Baerlocher reveals a number of steps associated with the player picked selection, wherein the offer the player may accept or reject is based on the accumulated number of revealed steps. On the other hand, in the gaming device of amended independent Claim 1, the offer which the player may accept or reject is directly associated with the player picked selection. Accordingly, for this reason, Applicants respectfully submit that amended independent Claim 1 is patentably distinguished over Baerlocher and in condition for allowance.

Claims 2 to 10 depend directly or indirectly from independent Claim 1 and are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

Similar to amended independent Claim 1, independent Claim 18 is directed to a method of operating a gaming device including, amongst other elements, directly associating a plurality of offers with a plurality of selections, enabling a player to pick a selection, communicating the offer associated with the picked selection to the player, and enabling the player to accept or reject the offer. For the reasons described above with respect to amended independent Claim 1, Applicants respectfully submit that amended independent Claim 18 is patentably distinguished over Baerlocher and in condition for allowance.

Claim 20 depends directly from independent Claim 18 and is also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in this claim.

Independent Claim 11 is directed to a gaming device having a game including a plurality of values, wherein each of the values is greater than zero, a plurality of player selectable selections, and a display device. The gaming device includes a processor which communicates with the display device, associates the values with the selections wherein each selection is associated with one of the values, and displays to a player the association between at least one of the values associated with one of the selections and the selection. The processor also causes the display device to display a rearrangement of the selectable selections wherein after the rearrangement of the selectable selections on the display, each selection remains associated with the previously associated value, enables the player to select one of the selections, and provides the player the value associated with the selected selection.

The Office Action states that Baerlocher teaches a gaming device which "causes a display device to display a rearrangement (reshuffling) of the selectable selections wherein after the rearrangement of the selectable selections on the display each selection remains associated with said previously associated value". This is incorrect. Baerlocher states that "[t]he game alternatively reshuffles or redistributes the numbers

of steps associated with the selections 108a through 108x after each offer and thereby provides a new order of steps associated with the selections 108a through 108x." Redistributing the numbers of steps associated with the selections after each offer is different than displaying to a player the association between at least one of the values associated with one of the selections and the selection and then displaying a rearrangement of the selectable selections wherein after the rearrangement of the selectable selections on the display, each selection remains associated with the previously associated value. The gaming device of independent Claim 11 includes displaying to a player the association between at least one of the values associated with one of the selections and the selection and then displaying a rearrangement of the selectable selections wherein after the rearrangement of the selectable selections on the display, each selection remains associated with the previously associated value. Accordingly, for this reason, Applicants respectfully submit that Claim 11 is patentably distinguished over Baerlocher and in condition for allowance.

Claims 12 to 17 depend directly from independent Claim 11 and are also allowable for the reasons given with respect to Claim 11, and because of the additional features recited in these claims.

Similar to independent Claim 11, independent Claim 21 is directed to a method of operating a gaming device including, amongst other elements, revealing one of the values associated with one of the selections to the player and displaying a rearrangement of the selections wherein after the rearrangement of the selections, each selection remains associated with the previously associated value. For the reasons described above with respect to independent Claim 11, Applicants respectfully submit that Claim 21 is patentably distinguished over Baerlocher and in condition for allowance.

The Office Action rejected Claims 12 to 14 and 16 to 17 under 35 U.S.C. 103(a) as being obvious over Baerlocher et al. (U.S. Patent No. 6,648,754).

As indicated in the Office Action, this rejection may be overcome by showing that the subject matter of Baerlocher et al. and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Accordingly, Applicants respectfully submit that

Baerlocher et al. is disqualified as prior art under 35 U.S.C. § 103(c) because at the time the present invention was conceived, the subject matter of Baerlocher et al. and the present invention were both subject to an obligation of assignment to IGT, a Nevada corporation.

The present application is assigned to IGT. The assignment from Andrea Hughes-Baird and Brian D. Swift to IGT was recorded February 28, 2002. A copy of the Notice of Recordation and the recorded assignment to IGT for the present application are enclosed herewith. Baerlocher is also assigned to IGT. The assignment from Anthony J. Baerlocher and Bayard S. Webb to IGT was recorded on March 30, 2001. A copy of the Notice of Recordation and the recorded assignment to IGT for Baerlocher et al. are enclosed herewith. Accordingly, Applicants respectfully submit that under § 103(c), Baerlocher et al. is not prior art to the present application, the rejections under 35 U.S.C. §103(a) have been overcome and Claims 12 to 14 and 16 to 17 are in condition for allowance.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this Response, Applicants respectfully request that the Examiner contact the undersigned to discuss this Response.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Adam H. Masia  
Reg. No. 35,602  
Customer No. 29159

Dated: October 12, 2005